UNITED STATES PATENT AND TRADEMARK OFFICE

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09/667,366	09/22/2000	Christopher John Ling	GB9-1999-0146US1	9751

45541 7590 09/28/2007	EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/667,366	LING, CHRISTOPHER JOHN
	Examiner	Art Unit
	Benjamin E. Lanier	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment filed 13 September 2007 amends claims 1, 7, and 15. Applicant's

amendment has been fully considered and entered.

Response to Arguments

2.   Applicant argues, "Shi fails to disclose responsive directly to a request from a client for a

web page hosted by a web server, storing an indicator that said client has requested a web page

hosted by said web server." This argument is not persuasive because Shi discloses the web server

sends a cookie to a requesting user as a result of an HTTP request by the user (Col. 8, lines 14-

63), which meets the limitation for the reasons stated below.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to

non-statutory subject matter. Claim 17 is drawn to computer software in general. "Functional

descriptive material consists of data structures and computer programs which impart

functionality when employed as a computer component." (MPEP 2106). When functional

descriptive material is recorded on some computer-readable medium it becomes structurally and

functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized. See Lowry, 32 F.3d at

1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to include, "responsive directly to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server." While the specification may disclose that an indicator/persistent client state object/cookie is stored responsive to a user request, no mention is made as to the directness of storage with respect to the request. Page 8, lines 1-15 of the specification discuss how the state object/cookie is created in response to the user request, such that the state object/cookie will include information relevant to the request prior to be distributed to the user, and then stored.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to include, "responsive directly to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server," which render the claims indefinite because it is unclear

how the indicator/persistent client state object/cookie can be stored before it is even created.

Storage as a direct result of request would require such a scenario. Page 8, lines 1-15 of the

specification discuss how the state object/cookie is created in response to the user request, such

that the state object/cookie will include information relevant to the request prior to be distributed

to the user, and then stored. Therefore, the claims will be treated in light of the specification,

which shows that the state object/cookie is stored as a result of the user request with possible

intermediate steps being performed prior to actual storage of the state object/cookie.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-9, 11-13, 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shi

et al., US patent 5,875,296.

In reference to claims 1, 17:

Shi et al. discloses a method of verifying a right to use an element of a web page hosted by a web

server, the method comprising the steps of:

- Responsive to a request from a client for a web page hosted by a web server, storing an

  indicator that said client has requested a web page hosted by said web server, where the

  indicator is a cookie, stored on the client side. (Column 8, lines 32-35) The process

  begins with the client making an HTTP request as disclosed by (Column 8, lines 14-31)

- Responsive directly to a request from a client for an element of a web page, checking for said indicator that said client has requested a web page from said web server, where in response to a client request for a webpage a test is made to see if the browser supports cookies, and if so, has a cookie previously been issued(checking said indicator that client has requested a webpage). (Column 8, lines 21-31)

- Responding to the request from the client for said element of a web page hosted by the web server according to the result of said checking step, where if the cookie authentication was not successful an HTML document describing the failure is returned. (Column 8, lines 51-60)

In reference to claim 2:

Shi et al. discloses a method as claimed in claim 1, wherein said storing step comprises:

Returning to the client a persistent client state object having an identifier therein;

And wherein said checking step comprises checking for said persistent client state object having the identifier therein returned by said client, prior to said responding step. (Column 8, lines 54-60)

In reference to claim 3:

Shi et al. discloses a method as claimed in claim 2 wherein the persistent client state object is a cookie. (Column 6, lines 49-51)

In reference to claim 4:

Shi et al. discloses a method as claimed in claim 2 wherein the persistent client state object

expires after a pre-determined period of time. (Column 7, lines 15-20)

In reference to claim 5:

Shi et al. discloses a method as claimed in claim 1 wherein said storing step comprises adding an

identity of said client to a table associated with said web server; (Column 8, lines 61-66)

And wherein said checking step comprises checking for client identity in said table, prior to said

responding step, where the checking step uses the cookie to check for credentials. (Column 8,

line 66) – (Column 9, line 13)

In reference to claim 6:

Shi et al. discloses a method as claimed in claim 1 wherein said table includes an expiry time

associated with a respective client identity in said table, where the unique id stored in a cookie, is

stored in a table (Column 8, lines 61-66) and where cookies have an expiry time associated with

a client identity in the table (Column 7, lines 15-20)

In reference to claim 7:

Shi et al. discloses a method of verifying a right to use an element of a web page hosted by a web

server, the method comprising the steps of:

- Responsive to a request from a client for an element of a web page, checking said request

  for an indicator that said request results from a client request for a web page hosting by

an authorized web server, where this request initiates searching for the authentication

cookie, which may or may not be included in the actual request itself (Column 9, lines 8-

10) and where the cookie is matched to see if it belongs to the right domain of

authorization, or an authorized web server (Column 7, lines 26-35) as part of the

authentication process. The indicator having been provided to the client by the authorized

web server in direct response to a request from the client for the web page hosted by the

authorized web server (Col. 8, lines 14-63).

- Responsive to the presence of such an indicator, responding to the request from the client

    with said element of a web page, where upon authentication the web document is

    retrieved. (Column 9, lines 3-10)

In reference to claim 8:

Shi et al. discloses a method as claimed in claim 7 wherein said indicator comprises a Uniform

Resource Locator for said web page, and said checking step comprises checking that said web

page URL is from an authorized web server. (Column 7, lines 25-35, lines 51-55) & (column 8,

lines 32-41)

In reference to claim 9:

Shi discloses the method as claimed in claim 7 wherein said indicator comprises a meta-tag

incorporated in web pages from authorized servers, and said checking step comprises checking

that said meta-tag is from an authorized web server (Col. 7, lines 44-60).

In reference to claim 11:

Shi et al. discloses a method as claimed in claim 7 operable in one of said web server or a proxy server connecting said web client to said web server, where (Figure 3) discloses the method operable in a web server connecting the web client to the web server.

In reference to claim 12:

Shi et al. discloses a method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning a message for display at the client to the client, where the message is an HTML document describing the error. (Column 8, lines 51-54)

In reference to claim 13:

Shi et al. discloses a method as claimed in claim 7 wherein if said checking steps fails to detect said indicator, said responding step comprises returning a substitute element to the client, where the substitute element is an HTML document with an error message. (Column 8, lines 51-54)

In reference to claim 15:

Shi et al. discloses a method in a web client of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

- Responsive directly to encountering a request for an element of a web page, checking that said request results from a client request for a web page hosted by an authorized web server, where this request results in authenticating the client by searching for the authentication cookie, where the cookie is matched to see if it belongs to the right domain of authorization (authorization server) (Column 7, lines 26-35), and if to be valid is

searched for the authentication credentials (the unique id) (Col. 8, lines 14-63 & Column

9, lines 3-10)

- Responsive to such a request, requesting said web page element from a server hosting

  said web page element, where upon authentication the web document is retrieved.

  (Column 9, lines 3-10)

The multiple dependent claim 16, is rejected for the same reasons as claims 1, 7 and 15.

In reference to claim 18:

Shi et al. discloses the method as claimed in claim 1, wherein if said checking step fails to detect

said indicator, said responding step comprises returning a message for display at the client to the

client, where the message is an HTML document describing the error. (Column 8, lines 51-54)

In reference to claim 19:

Shi et al. discloses the method as claimed in claim 1, wherein if said checking step fails to detect

said indicator, said responding step comprises returning a substitute element to the claim, where

the substitute element is an HTML document with an error message. (Column 8, lines 51-54)

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 14, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al, US

patent 5,875,296.

In reference to claim 14:

Shi et al. fails to explicitly disclose a method as claimed in claim 7 wherein if said checking step

fails to detect said indicator, said responding step comprises returning no response to the client.

It would have been obvious to one of ordinary skill in the art at the time of invention, to ignore

requests that weren't authenticated, and return no response to the client in order to conserve

bandwidth by not sending any error message.

In reference to claim 20:

Shi et al. fails to explicitly disclose a method as claimed in claim 1 wherein if said checking step

fails to detect said indicator, said responding step comprises returning no response to the client.

- It would have been obvious to one of ordinary skill in the art at the time of invention, to

   ignore requests that weren't authenticated, and return no response to the client in order to

   conserve bandwidth by not sending any error message.

10.   Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over over Shi et al, US

patent 5,875,296, in view of Houston, U.S. Patent No. 6,353,929. Referring to claim 10, Shi does

not specify that the URL/domain meta-data is PICS compliant. However, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to use a PICS
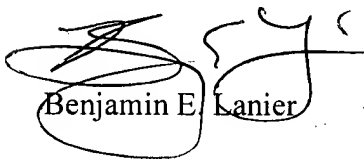
compliant tag for the URL/domain meta-data for the cookies in Shi because PICS is the World

Wide Web Consortium endorsed standard for tagging information on the Internet as taught by

Houston (Col. 2, lines 27-31).

Conclusion

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805.

The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin E. Lanier